

**REMARKS**

The present amendment is in response to the Official Action mailed May 18, 2007. Claims 1, 4, 8, 32, and 36 have been amended. Claims 2, 3, and 15-31 were previously canceled. Therefore, claims 1, 4-14, and 32-40 remain pending in the present case. The following sets forth Applicant's remarks pertaining to the currently pending claims and the outstanding action.

As an initial matter, Applicant wishes to thank the Examiner for conducting the brief telephone discussion of September 11, 2007, with Applicant's undersigned counsel. In that discussion, the Examiner discussed the outstanding action and requested that Applicant submit a written response to same. The present amendment is in fact that written submission. Essentially, Applicant has amended independent claims 1 and 32 to require that the first and second blocks be sized to engage the bone-facing cavity, in accordance with suggestions set forth by the Examiner in the action as well as in the telephone discussion of September 11<sup>th</sup>. In addition, Applicant has also amended independent claim 1 and dependent claims 4, 8, and 36 to overcome the § 112 rejections discussed below.

In the Official Action, the Examiner rejected claims 1, 4-11, 13, 14, and 36-39 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In short, the Examiner noted the use of the term "the trial" and the possible confusion as to whether this term referred to "the trial augment" or "the trial distal femoral component." As is mentioned above, Applicant has amended independent claim 1 and dependent claims 4, 8, and 36 to overcome this rejection. Applicant respectfully submits that the amendments of such claims clear up any confusion as to what

element is being referred to. Applicant respectfully requests removal of the § 112 rejections accordingly.

Further in the action, the Examiner also rejected claims 1, 4-11, and 32-39 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,416,552 to Hoeppner et al. ("*Hoeppner*"), and claims 13, 14, and 40 under 35 U.S.C. § 103(a) as being obvious in view of *Hoeppner*. Essentially, the Examiner asserted that *Hoeppner* teaches a first and second block arrangement shown in FIGS. 22 and 23, in which the blocks are biased and are capable of engagement with a bone-facing cavity 56 of the distal femoral component 1E shown in FIGS. 17 and 18. Moreover, the Examiner noted in connection with the obviousness rejections that while *Hoeppner* does not specifically teach a surgical tray, such would have been obvious to one of ordinary skill in the art. Applicant respectfully disagrees with the Examiner's rejections of the currently dependent claims.

Applicant notes that the *Hoeppner* reference is directed to a method and apparatus for enabling access to an intermedullary canal of a femur through a femoral knee joint prosthesis. This access is basically achieved by providing a femoral knee prosthesis that defines a bore passing therethrough, and a seal member which seals the bore and is operable to be opened to enable access to the intermedullary canal of the femur. One embodiment of the seal member is that which is disclosed in FIGS. 22 and 23 of *Hoeppner*, and specifically noted by the Examiner. However, this configuration is far different from the present invention in which a trial augment is utilized to properly size a bone-facing cavity of a trial implant. Where the seal member of *Hoeppner* is designed to be placed in a section between the two bone-engaging cavities of the femoral trial taught therein, the present invention is meant to be placed in the cavity.

Applicant has amended both currently pending independent claims to more particularly claim the structure of the present invention. Specifically, both independent claim 1 and independent claim 32 have been amended to include the limitation that "the first and second blocks are sized to engage the bone-facing cavity" of the trial distal femoral component. In addition, Applicant has amended such claims to require that the first and second blocks "form a substantially flat bone-facing surface which is coplanar with a bone surface." *Hoepfner* teaches neither of these additional limitations, but rather only discloses a seal member for sealing a bone formed in a knee prosthesis. Therefore, Applicant points out a significant difference between *Hoepfner* and the presently claimed invention. In fact, Applicant respectfully submits that the above amendments to the currently pending claims overcome the rejections in view of *Hoepfner*.

In light of all of the above, Applicant respectfully requests allowance of the present matter. Because the remaining claims in the application depend from either independent claim 1 or 32, such claims also constitute allowable subject matter. A dependent claim is necessarily narrower than an independent claim from which it properly depends. Thus, in view of all of the above, Applicant respectfully requests allowance of each and every one of currently pending claims 1, 4-14, and 32-40.

As it is believed that all of the rejections set forth in the Official Action have been fully met, favorable reconsideration and allowance are earnestly solicited.

If, however, for any reason the Examiner does not believe that such action can be taken at this time, it is respectfully requested that he telephone Applicant's attorney at (908) 654-5000 in order to overcome any additional objections which he might have.


Application No.: 10/678,352

Docket No.: OSTEONICS 3.0-466

If there are any additional charges in connection with this requested amendment, the Examiner is authorized to charge Deposit Account No. 12-1095 therefor.

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Respectfully submitted,

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